

REMARKS

After entry of the amendments, claims 50-54, 83-97 and 99-108 will be pending in the application. Claims 50-54 have been withdrawn from consideration. Claims 98 and 109 have been canceled without prejudice or disclaimer. Claims 83-97 and 99-108 stand rejected.

Applicants have reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicants submit that the following remarks are fully responsive to the final Office action, and that all pending claims are patentable over the cited references.

Rejections Under 35 U.S.C. § 112

Claims 98 and 109 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants have canceled claims 98 and 109. This rejection is now moot.

Rejections Under 35 U.S.C. § 102

Claims 83, 89, 90, 94 and 97 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Choy (US 4,207,874). Applicants respectfully disagree.

To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that Choy fails to meet this standard.

First, Choy fails to teach or disclose a suction well. More specifically, Choy does not teach or disclose "at least one suction well that surrounds a perimeter of the at least one ablating element" as recited in claim 83. Choy describes a conduit 10 having a

fiberoptic bundle 16 at the distal end of the conduit 10 and an annular space between the walls of the conduit 10 and the fiberoptic bundle 16. Choy, col. 3:46-58 ("The bundle 16 is separated from the walls of the conduit 10 by an annular space."). Nowhere does Choy describe a suction well surrounding a perimeter of an ablating element. Indeed, the examiner does not identify any structure in Choy that allegedly constitutes a suction well. See Office action, at page 3, 3rd paragraph from the bottom.

Second, Choy fails to teach or disclose "a closed wall defined by an inner lip of the at least one suction well". The examiner alleges that "the laser fiber is the ablating element" and "the ring of illumination fibers (see Fig. 4)¹ constitutes an inner lip". Office action, at page 3. Even assuming the correctness of this argument, which Applicants respectfully contest, the light source conducting fibers 24 do not "surround a perimeter of" the laser energy conducting fibers 26. See Choy, col. 4:12-18 and Fig. 3. Claim 83 recites "a closed wall defined by an inner lip of the at least one suction well *surrounds the perimeter of* the at least one ablating element." As shown in Fig. 3 of Choy, the laser energy conducting fibers 26 and the light source conducting fibers 24 together form a fiberoptic bundle, with a portion of the fibers in the bundle being laser fibers and another portion of the fibers being illuminating fibers. See *also* Choy col. 4:12-18. Thus, the light source conducting fibers cannot constitute the claimed "inner lip" because the light source conducting fibers do not surround a perimeter of an ablating element. Further, the light source conducting fibers do not constitute "a closed wall" as recited in the claims. See *e.g.*, Choy, Fig. 3 (the light source conducting fibers form only half of the fiberoptic bundle).

For at least the foregoing reasons, Applicants respectfully submit that Choy fails to explicitly or inherently teach each and every element of the claimed invention. Thus, Choy does not anticipate claim 83, nor claims 89, 90, 94 and 97, which depend from claim 83. Accordingly, Applicants respectfully request withdrawal of this rejection.

¹ Applicants note that Fig. 4 does not depict a ring of illumination fibers (perhaps the examiner intended to refer to Fig. 3).

Claims 83-89, 94, 96-101, 104 and 109 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Edwards, et al. (US 6,325,798). Applicants respectfully disagree.

Applicants respectfully assert that Edwards fails to explicitly or inherently teach each and every element of the claimed invention. Regarding independent claim 83, Edwards does not teach or disclose “at least one suction well *that surrounds a perimeter of the at least one ablating element*, wherein a closed wall defined by an inner lip of the at least one suction well surrounds the perimeter of the at least one ablating element.” Regarding independent claim 104, Edwards fails to teach or disclose at a minimum “a continuous suction well *surrounding the at least one ablating element*.”

The device in Edwards includes an electrode carrier 250 having a generally cylindrical housing 252 and a series of circumferentially spaced electrode pods 256 extending radially outward of the housing 252. Edwards, col. 30:1-6. “Each pod 256 includes an interior electrode guide bore 258... [that] extends in a curved path through the pod 256 and terminates with an electrode port 262 spaced outward from the wall of the housing.” *Id.* col. 30:7-11. “The housing 252 also includes a series of suction ports 260 ... located flush with the housing wall 268 *close to* an electrode port 262. The suction ports 260 are coupled to a source of negative pressure through a port 274 on the handle 240.” *Id.* col. 30:12-16 (emphasis added).

As described in Edwards, the suction ports 260 are “close to” but do not “surround” an ablating element as recited in claims. See Edwards, col. 30:12-16. Further, it is clear from Fig. 68 of Edwards that the suction ports 260 do not surround the electrode guide bores 258. Because Edwards fails to explicitly or inherently teach each and every element of the claimed invention, Edwards cannot anticipate independent claims 83 and 104.

The examiner limits his analysis of Edwards to a single sentence. According to the examiner, "Edwards et al ('798) teach a device as claimed (see Figures 68-71) wherein the insulation of the electrode constitutes the inner lip of the suction well." Office action, at page 3. The examiner fails to clearly articulate the rejection as required by the Patent Office's rules of procedure. See MPEP § 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."). Aside from the inner lip, the examiner provides no explanation or reasoning regarding where Edwards allegedly teaches or discloses the claim elements, and, as discussed above, Applicants contend that Edwards cannot anticipate claims 83-89, 94, 96-101, 104 and 109 because Edwards fails to teach each and every element of the claims. To the extent the examiner disagrees, Applicants respectfully request that the examiner set forth in detail, and with reference to column/line number and/or the figures, where each and every element of claim 83 is disclosed in Edwards.

The examiner alleges that the insulation of the electrode constitutes the inner lip of the suction well, but the examiner does not identify where Edwards allegedly discloses a suction well. Moreover, it is not clear how the insulating material could possibly constitute an inner lip. The insulating material 278 "is coated about the proximal end of each electrode 264", Edwards, col. 30:29-32, but does not form any part of or even come in contact with a suction well.² Claim 83 states "a closed wall defined by *an inner lip of the at least one suction well* surrounds the perimeter of the at least one ablating element." Applicants submit that the insulating material cannot constitute an inner lip of a suction well where no suction well is associated therewith.

Regarding independent claim 104, the examiner fails to articulate any reasoning whatsoever to support the rejection of this claim. Applicants respectfully contend that

² The examiner does not allege that the suction port 260 is a suction well, but even if the examiner takes such a position, the insulating material 278 still would not constitute an inner lip because the insulating material 278 does not form any part of the suction port 260.

Edwards fails to teach or disclose "a continuous suction well surrounding the at least one ablating element" as recited in claim 104. Thus, Edwards cannot anticipate claim 104. To the extent the examiner disagrees, Applicants respectfully request that the examiner set forth in detail, and with reference to column/line number and/or the figures, where each and every element of claim 104 is disclosed in Edwards.

Applicants respectfully submit that Edwards does not anticipate claims 83 and 104 because Edwards fails to explicitly or inherently teach each and every element of the claimed invention. For the same reasons, Edwards also does not anticipate claims 84-89, 94, 96, 97 and 99-101, which depend from claim 83. Applicants note that claims 98 and 109 have been canceled. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

Claims 84-88, 91-93 and 95 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Choy.

Claims 84-88, 91-93 and 95 depend from claim 83. The shortcomings of Choy with respect to claim 83 are discussed above. Applicants submit that the Examiner has not met the burden of establishing a *prima facie* case that independent claim 83 is anticipated by, much less obvious over, Choy. Therefore, dependent claims 84-88, 91-93, and 95 are non-obvious over Choy because the independent claim from which they depend is non-obvious over the cited reference. MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 1076 (Fed Cir. 1988). Furthermore, Applicants submit that the differences between the rejected claims and the reference cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. See 35 U.S.C. § 103.

For at least these reasons, Applicants respectfully submit that claims 84-88, 91-93 and 95 are substantially different from, and therefore non-obvious over Choy. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 90-93, 95, 102, 103 and 105-108 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Edwards.

Claims 90-93, 95, 102 and 103 depend from claim 83. Claims 105-108 depend from claim 104. The shortcomings of Edwards with respect to claims 83 and 104 are discussed at length above. Applicants submit that the Examiner has not met the burden of establishing a *prima facie* case that independent claims 83 and 104 are anticipated by, much less obvious over, Edwards. Therefore, dependent claims 90-93, 95, 102, 103 and 105-108 are non-obvious over Edwards because the independent claims from which they depend are non-obvious over the cited reference. MPEP 2143.03; *In re Fine*, 837 F.2d at 1076. Furthermore, Applicants submit that the differences between the rejected claims and the reference cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. See 35 U.S.C. § 103.

For at least these reasons, Applicants respectfully submit that claims 90-93, 95, 102, 103 and 105-108 are substantially different from, and therefore non-obvious over Edwards. Accordingly, Applicants respectfully request withdrawal of this rejection.

Double Patenting Rejections

The Examiner rejects claims 83-95 on the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States patent no. 5,830,214 to Flom et al. ("Flom"). Applicants submit that this rejection is improper because Flom is not commonly-owned with the present application. MPEP § 804.

Application No. 10/823,411
Office action dated February 20, 2009
Response and Amendment dated May 11, 2009

The Examiner provisionally rejects claims 83-95 of the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States application no. 11/882,072. Applicants will submit a terminal disclaimer to overcome this double patenting rejection upon receiving an indication of allowable subject matter in the application.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0E-040042US/82410-0181.

Respectfully submitted,

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